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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/723,001	11/24/2003	Richard Postrel	700-148RPB	9559
24002	7590	08/30/2004	EXAMINER	
ANTHONY R BARKUME 20 GATEWAY LANE MANORVILLE, NY 11949			MEINECKE DIAZ, SUSANNA M	
			ART UNIT	PAPER NUMBER

3623

DATE MAILED: 08/30/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/723,001

Applicant(s)

POSTREL, RICHARD

Examiner

Susanna M. Diaz

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 November 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,4,6,7,11,12,14-16,18,20,21,25,26,28 and 30-49 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,4,6,7,11,12,14-16,18,20,21,25,26,28 and 30-49 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 November 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 1, 2, 4, 6, 7, 11, 12, 14-16, 18, 20, 21, 25, 26, 28, and 30-49 are presented for examination.

Claim Objections

2. Claims 30, 31, 39, and 40 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form.

Double Patenting

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 1, 2, 4, 6, 7, 11, 12, 14-16, 18, 20, 21, 25, 26, 28, and 30-49 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 30-130 of copending Application No.

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10/608,736. Although the conflicting claims are not identical, they are not patentably distinct from each other because the same allowable combination of features is recited in both sets of claims. Differences in the claim language are found in nominal details, such as the specific application of each invention.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

5. Claims 1, 2, 4, 6, 7, 11, 12, 14-16, 18, 20, 21, 25, 26, 28, and 30-49 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 30-69 and 71-76 of copending Application No. 10/648,705. Although the conflicting claims are not identical, they are not patentably distinct from each other because the same allowable combination of features is recited in both sets of claims. Differences in the claim language are found in nominal details, such as the specific application of each invention.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

6. Claims 1, 2, 4, 6, 7, 11, 12, 14-16, 18, 20, 21, 25, 26, 28, and 30-49 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-47 of U.S. Patent No. 6,594,640. Although the conflicting claims are not identical, they are not patentably distinct from each other because the same allowable combination of features is recited in both sets of claims. Differences in

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the claim language are found in nominal details, such as the specific application of each invention.

Allowable Subject Matter

7. Claims 1, 2, 4, 6, 7, 11, 12, 14-16, 18, 20, 21, 25, 26, 28, and 30-49 would be allowable if rewritten to overcome the claim objections and if a terminal disclaimer(s) were filed to obviate the Double Patenting rejections, set forth in this Office action.

8. The following is an examiner's statement of reasons for allowance:

The following references have been identified by the Examiner as the closest prior art of record:

(1) MyPoints™ Program, as disclosed in the following references:

(a) Information about the MyPoints™ Program retrieved on July 26, 2002 from Internet

<URL:<http://web.archive.org/web/19980128231040/http://www.mypoints.com>>, herein referred to as MyPoints™ Program web site. This web site was archived by web.archive.org on January 28, 1998.

(b) Oberndorf, "Points for Loyalty," published December 1997.

(c) Riedman, "MyPoints Aims to Be Universal Web Currency," published August 18, 1997.

(2) Borge et al. (U.S. Patent No. 5,806,045).

(3) Schlumberger Payflex card, as disclosed in the following references:

- (a) "World's First Smart Card Frequent Flyer Scheme Debuts," published September 19, 1997.
- (b) "Major Airlines Continue Their Smart Card Fly-bys," published January 1998.
- (c) "Schlumberger: AOM's Smart Card Frequent Flyer Program Successfully Launched," published May 22, 1998.
- (4) Walker et al. (U.S. Patent No. 6,128,599).

Similar to the claimed invention, the MyPoints™ Program is a reward points accumulation and redemption program. Also, the MyPoints™ Program allows a user to gather points from different reward points issuing entities. All gathered points are accumulated in a universal account from which points may be redeemed through a trading server. However, unlike the claimed invention, MyPoints™'s users do not have control over which reward points are accumulated in the universal account; all MyPoints™'s reward points are accumulated in the universal account regardless of which reward points issuing entity issued the reward points. Neither the MyPoints™ Program nor any of the other aforementioned references teaches or suggests the novel aspects of the claimed invention which allow a user to maintain at least one separate reward points account and then selectively choose how many points and from which reward points account(s) to assign a separate reward points accumulation thereof. These novel aspects are recited in claims 1, 2, 4, 6, 7, 11, 12, 14-16, 18, 20, 21, 25, 26,

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28, and 30-49; therefore, claims 1, 2, 4, 6, 7, 11, 12, 14-16, 18, 20, 21, 25, 26, 28, and 30-49 are all deemed to be allowable over the prior art of record.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to Applicant's disclosure. Please note that all references marked with an asterisk on the attached PTO Form 892 are not being provided to Applicant since Applicant was already supplied with a copy of each marked reference in parent applications.

Blagg (US 2003/0182218) -- Discloses the ability to pool reward points held in various related accounts (¶¶ 175-184).

Helbig (US 2002/0116257) -- Discloses an online incentive program.

Anderson et al. (WO 01/01278 A2) -- Discloses a server-based system for monitoring points across various loyalty programs and allowing a user to redeem and convert points.

"Transmedia Europe, Inc. and Transmedia Asia Pacific, Inc. Announce the Acquisition of a Silicon Valley Internet Loyalty and Member Benefit Provider" -- Discloses Award Track, Inc.'s server-based system for monitoring points across various loyalty programs and allowing a user to redeem and convert points.

Eggleston et al. (U.S. Patent No. 6,061,660) – Discloses an incentive program customized to each retailer's needs.

Walker et al. (U.S. Patent No. 6,049,778) – Discloses an incentive program in which rewards are granted based on a product's success.

Fredregill et al. (U.S. Patent No. 5,923,016) – Discloses an in-store points redemption program.

Ferguson et al. (U.S. Patent No. 5,991,736) – Discloses an incentive program that credits a monetary award to a customer's retirement account.

Messner (U.S. Patent No. 6,370,514 B1) – Discloses a method for marketing and redeeming vouchers for use in online purchases.

Paltenghe et al. (EP 0 917 120 A2) – Discloses a virtual wallet system in which a smart card can be a proxy to a wallet server where currency is stored.

"Chip Cards Get a Loyal Corporate Following" – Discloses a smart card loyalty points program.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Susanna M. Diaz whose telephone number is (703) 305-1337. The examiner can normally be reached on Monday-Friday, 9 am - 5 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tariq Hafiz can be reached on (703) 305-9643.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Receptionist whose telephone number is (703)308-1113.

Any response to this action should be mailed to:

**Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450**

or faxed to:

(703)305-7687 [Official communications; including
After Final communications labeled
"Box AF"]

(703)746-7048 [Informal/Draft communications, labeled
"PROPOSED" or "DRAFT"]

Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive, Arlington, VA, 22202, 7th floor receptionist.



Susanna M. Diaz
Primary Examiner
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August 20, 2004